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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

NGUYEN, TUYEN T

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/929,068

Applicant(s)  
Hsien et al.

Examiner  
Tuyen T. Nguyen

Art Unit  
2832



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Aug 15, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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### **DETAILED ACTION**

#### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the core being embedded in the insulating element must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 1, applicant should clarify what is intended by "a base for transforming an inductor". In lines 2-3, applicant should clarify what is intended by "into a surface mounted device." In line 3, "comprising," should be --comprising:--. It is unclear what applicant means by "a strip of first/second stem." Applicant should clarify how the insulating element "partially" exposes a lower surface of the first/second conductive element. The term "substantially" throughout the claim is a relative term. Applicant should clarify the specific arrangement of the terminals. Claims 2-8 inherit the defects of the parent claim.

Regarding claim 5, applicant should clarify the structure of the recessed edge.

Regarding claim 9, line 1, applicant should clarify what is intended by "a base for transforming an inductor". In lines 2-3, applicant should clarify what is intended by "into a surface mounted device." In line 3, "comprising," should be --comprising:--. The term "substantially" throughout the claim is a relative term. It is unclear what applicant means by "a strip of first/second stem." Applicant should clarify structure of the recessed edge. Applicant should clarify how the insulating element exposes the stems/sections. Applicant should clarify the structure and arrangement of "a drop." Claims 10-18 inherit the defects of the parent claim.

Regarding claim 10, applicant should clarify how the core structure is embedded in the insulating element.

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Regarding claims 11 and 12, applicant should clarify the structure/location of the "virtual cross sectional line."

Regarding claim 19, should clarify what is intended by "a base for transforming an inductor". In lines 2-3, applicant should clarify what is intended by "into a surface mounted device." In line 3, "comprising," should be --comprising:--.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 19, as best understood in view of the rejection under 112 second paragraph, is rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. [US 5,307,041].

Kato et al. discloses an inductor device comprising:

- an insulating element [1]
- a plurality of *substantially Z shaped* terminal elements [2] embedded in the insulating element; and
- coil winding [4] having ends connected to the terminal elements.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-19, as best understood in view of the rejection under 112 second paragraph, are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art of figure 1 in view of JP 2-256212 and Kato et al. [US 5,307,041].

Applicant's admitted prior art of figure 1 discloses the instant claimed invention except for the specific structure and arrangement of the conductive elements.

JP 2-256212 discloses *substantially Z shaped* terminal elements [see figure 1] embedded in an insulating base [9] having exposed portions and first and second stem portions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Z-shaped terminal design of JP 2-256212 in applicant's admitted prior art of figure 1 for the purpose facilitating manufacture.

Applicant's admitted prior art of figure 1 in view of JP 2-256212 discloses the instant claimed invention except for the terminal elements having recesses.

Kato et al. discloses terminal elements [2] embedded in an insulating base [1] including exposed portions [2a] having notches [see figure 1b.]

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the terminal design of Kato et al. in applicant's admitted prior art of figure 1, as modified, for the purpose of facilitating connections.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Tuyen T. Nguyen whose telephone number is (703) 308-0821.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Elvin Enad, can be reached at (703) 308-7619. The fax number for this Group is (703) 305-7724.

Any inquiry of a general nature or relating to status of this application of proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

TTN *TTN*

May 29, 2002

*Tuyen T. Nguyen*